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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213597
Party	Defendant Tigercat International Inc.
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Date	05/07/2015
Attachments	REDACTED BRIEF - TIGERCAT REPLY BRIEF ISO MOTION FOR SANC- TIONS (M1369331).pdf(486182 bytes)

REDACTED BRIEF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CATERPILLAR INC.,	:	
	:	
OPPOSER,	:	
	:	
v.	:	Opposition No. 91213597
	:	
TIGERCAT INTERNATIONAL INC.	:	
	:	
APPLICANT.	:	

**APPLICANT TIGERCAT INTERNATIONAL INC.'S BRIEF IN REPLY TO OPPOSER
CATERPILLAR INC.'S BRIEF IN OPPOSITION TO APPLICANT'S MOTION FOR
SANCTIONS AND SUSPENSION OF PROCEEDINGS**

Applicant Tigercat International Inc. ("Applicant" or "Tigercat") submits the following reply to Caterpillar Inc.'s ("Opposer") response to Tigercat's Motion for Sanctions and Suspension of Proceedings.

I. OPPOSER DID NOT COMPLY WITH THE BOARD'S ORDER

Opposer's assertion that it has complied with the Board's order is simply false. Opposer alleges that through its production of 2,000 documents on March 6, 2015, the date on which its production was due pursuant to the Board's Order, it complied with the Board's Order. *Opposer Caterpillar Inc.'s Brief in Opposition to Applicant Tigercat International Inc.'s Motion for Sanctions and Suspension of Proceedings to Applicant @ p. 3* [Dkt. No. 33]. However, much of Opposer's production on that date was unresponsive and much of the rest of that production was incomplete. *Bell Dec. Ex. A* [Dkt. No. 26]. Opposer accordingly failed to comply with the Board's Order.

Although Tigercat had no obligation to attempt yet again to secure from Opposer the information and materials Opposer had to be ordered to produce, *TBMP 527.01(a)*, Tigercat

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pressed Opposer to remedy its failure to comply with the Board's Order before filing its motion for sanctions on April 7, 2015. *Bell Dec. Ex. A, C, and E* [Dkt. No. 26].

In a pointless attempt to frame its discovery deficiencies as insignificant, Opposer states that it has produced 22,294 pages in discovery, "in contrast [to] Tigercat, [which] has produced less than 2,000 pages." *Opp. 's Brief* @ p. 5. The number of pages Opposer has produced, which are not responsive to the discovery which is the subject of the Board's Order, is immaterial. What matters is the quality of the production, and whether the documents produced are responsive to the requests which are the subject of the Board's Order, not the quantity of documents. If Opposer had any issue with the adequacy of Tigercat's production, it has not raised any such issue with Tigercat. Opposer's conduct in connection with discovery has been nothing short of obstructive, as demonstrated by the following.

A. Opposer Has Not Yet Complied With The Board's Order With Respect To Interrogatory No. 12

Opposer has failed to adequately respond to Tigercat's Interrogatory No. 12. Interrogatory No. 12 asked for "all third party uses of 'CAT' as a mark or name or component of a mark or name in connection with any goods or services identified in Opposer's Registrations", as amended by the Board's Order. Rather than provide a response to the interrogatory asked, in its supplemental responses to Interrogatory No. 12, Opposer produced a summary of references to third-party applications incorporating "cat" for the last three years in document batch CAT011741-CAT012902, search reports from 2012 of references for third-party registrations incorporating "cat" in document batch CAT013000-CAT021080 and a limited table admitted to be incomplete of common law marks with respect to which Opposer claims it "has either reached an amicable resolution with...or elected not to approach them due to sufficient differences between the parties' marks and/or goods or services". *Bell Dec. Ex. G* @p. 17 [Dkt. No. 26].

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The reports produced are not responsive to the request for identification of third party use of marks which contain “cat” as an element and are used in connection with goods and services of the type identified in Opposer’s pleaded registrations. Opposer attempts to excuse its failure to comply with the Board’s Order by complaining that Tigercat did not define “uses” in its Interrogatories, so it “expansively identified ‘uses’ to include both uses in commerce as well as other trademark uses, such as the filing of a trademark application.” *Opp. ’s Brief* @ p. 16. Opposer cannot excuse its failure to comply with the Board’s Order by pretending that it can claim the filing of an application to be “use” of a mark so that it can provide what it elects to provide by way of answer and so does not have to answer the interrogatory as stated and as so ordered. Third party use is not an application, and it is not a registration. Third party use is use, in intrastate as well as interstate commerce, of marks which contain or comprise the term “cat”, not generally but in connection with goods and services of the type identified in Opposer’s pleaded registrations. The Notice of Opposition shows that Opposer understands what “use” of a mark is. Opposer states that, “Opposer, through its predecessors-in-interest and related companies, has continuously used the CATERPILLAR trade name and trademark in the United States”. *Notice of Opp.* ¶ 2 [Dkt. No. 1].

Opposer has engaged in an effort to inflate the volume of its production with unresponsive documents as well as old and irrelevant documents.¹ It has meanwhile failed to comply with the Board’s Order. It still has not produced in response to Interrogatory No. 12 the third party uses known to it of marks and names which have as a component “CAT” in connection with any goods or services identified in Opposer’s registrations. It cannot evade its obligation to respond to the discovery it has been ordered to respond to by identifying uses on

¹ e.g., Annual Reports from 1999 and 2000, (CAT03104- CAT03149); advertisements from 1979-1981, (CAT04509-CAT04510, CAT04512), and Caterpillar Dealer Directories from 1989-2001, (CAT04537-CAT04615).

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other and unrelated goods such as²: [REDACTED] (CAT014760); [REDACTED]

[REDACTED] (CAT014762); [REDACTED]

[REDACTED] (CAT018031); [REDACTED]

[REDACTED] (CAT018035); [REDACTED]

[REDACTED] (CAT020319); and [REDACTED]

[REDACTED] (CAT019585).

In its Response Brief, Opposer says that “Tigercat cannot now complain as it has received more discovery that it wanted.” *Opp. 's Brief* @ p. 17. Opposer misstates the issue. Tigercat is prepared to ignore the unresponsive documents. What Tigercat is entitled to is the discovery it wanted and the discovery the Board ordered Opposer to provide. Opposer has not yet produced what it was ordered to provide and cannot avoid its obligation by pointing out that it produced something else. With respect to Interrogatory No. 12, Opposer has failed to comply with the Board’s Order.

B. Opposer Has Not Yet Complied With The Board’s Order With Respect To Requests For Production Nos. 24, 26, 27, 28 And Interrogatories Nos. 9 And 11

Opposer has still not complied with the Board’s Order with respect to Tigercat’s Requests For Production Nos. 24, 26, 27, 28 and Interrogatories Nos. 9 and 11. These Requests and Interrogatories seek documents and information relating to market research and consumer studies done by or on behalf of Opposer or any third party related to (1) Opposer’s marks as pled in the Notice of Opposition (“Opposer’s Marks”); (2) purchaser recognition, (3) consumer recognition and (4) recognition or awareness of Opposer’s Marks, limited in temporal scope to the last five years. Opposer was ordered to provide a supplemental narrative response to

² The redactions are based on designations by Opposer of the referenced documents as Confidential.

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Interrogatories Nos. 9 and 11 and to provide a representative sampling, as appropriate, of responsive documents. If Opposer has no surveys or other market research directed to purchasers' or consumers' perception or awareness and recognition of Opposer's Marks and does not intend to rely on such materials and information accordingly, it should simply so state.

Instead, Opposer has produced a number of "brand valuation" materials and customer satisfaction surveys and focus group reports directed to specific ad campaigns and then has misrepresented the nature of its production. By way of example, documents CAT11091-CAT011164 are alleged by Opposer to be ³ [REDACTED]

[REDACTED] *Bell*

Dec. Ex. G @ p. 18 [Dkt. No. 26]. The report, [REDACTED]

[REDACTED] The report's stated purpose is the [REDACTED]

[REDACTED] (CAT011159). *Id.* The report, by its own criteria, [REDACTED]

[REDACTED] *Id.* This report, in sum, is not

responsive to any of the Interrogatories or Requests for Production to which a response was ordered.

Documents CAT021428-021450 and CAT021451-021480⁴ are reports not specific to the U.S. market, evaluating advertising campaigns, not perception, awareness or recognition by the

³ The redactions are based on designations by Opposer of the referenced documents as Highly Confidential.

⁴ The redactions are based on designations by Opposer of the referenced documents as Trade Secret/Commercially Sensitive.

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relevant and general public of Opposer's Marks relied on by Opposer in this proceeding, as requested in Tigercat's discovery which is the subject of the Board's Order.

Opposer mischaracterizes its belated supplemental production with respect to other materials. By way of example, it refers to documents CAT021396- CAT021423 as a ⁵ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *Opp. 's Brief, Johnson Dec. Ex. C* "Opposer's Second Supplemental Objections and Responses to Applicant's First Set of Interrogatories (Nos. 9 and 11)", page 5, [Dkt. No. 34].

There is no indication of what was asked or what was answered, but it is evident that [REDACTED]

[REDACTED] (CAT021397) [REDACTED]

[REDACTED] (CAT021398). It is directed to [REDACTED]

[REDACTED]

[REDACTED] The documents

Opposer produced are not responsive documents to Tigercat's Requests For Production Nos. 24, 26, 27, and 28 in that the document are not related to (1) purchaser recognition, (2) consumer recognition or (3) recognition or awareness of Opposer's Marks nor are Opposer's Second Supplemental Responses responsive to Interrogatories Nos. 9 and 11.

Opposer has failed to comply with the Board's Order.

⁵ The redactions are based on designations by Opposer of the referenced documents as Trade Secret/Commercially Sensitive. See *Opp. 's Brief* @ p. 8, footnote 2.

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II. OPPOSER'S FAILURE TO COMPLY WITH THE BOARD'S ORDER IS SANCTIONABLE MISCONDUCT

Opposer's conduct for failing to comply with the Board's Order is sanctionable. 37 *CFR* §2.210(g). Opposer alleges that it timely supplemented its discovery responses as required under Fed. R. Civ. P. 26(e)(1)(a). Opposer did not comply with the Board's Order to supplement its discovery responses by March 6, 2015 and Opposer has still not fully complied with the Board's Order.

Tigercat has been prejudiced by Opposer's failure to meet the Board's March 6, 2015 deadline and its continued failure to comply with the Board's Order. Tigercat's experts have not had the opportunity to consider material which may bear on the subject of their expert disclosures, which were served on April 13, 2015 as required by the scheduling order. Tigercat's trial preparation is otherwise impeded by Opposer's failure to produce materials and information which have a material bearing on Opposer's grounds for opposition.

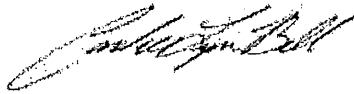
When Tigercat advised Opposer of the deficiencies in its belated responses, Opposer delayed and made excuses and raised unfounded arguments, and has still not produced the material and information it was ordered to produce by March 6, particularly with respect to (1) third party use of marks containing or comprising the term CAT in connection with goods or services identified in Opposer's registrations which Opposer has relied on in this opposition and (2) market research and consumer research relating to Opposer's Marks over the last five years and to relevant purchasers' or consumers' recognition or awareness of Opposer's Marks over the last five years.

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III. CONCLUSION

In view of the foregoing, Tigercat respectfully requests that Applicant's Motion for Sanctions be granted.

Respectfully submitted,



Date: May 7, 2015

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CERTIFICATE OF SERVICE

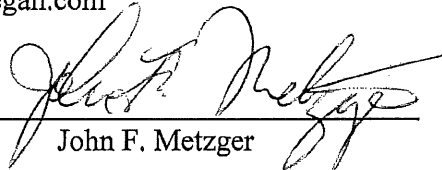
The undersigned hereby certifies that a true and correct copy of the attached Applicant's Brief in Reply to Opposer's Brief in Opposition to Applicant's Motion for Sanctions and Suspension of Proceedings was served on counsel for the Opposer on the date listed below via email and courtesy copy by U.S. Mail:

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By:


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